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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,924	04/26/2001	Craig S. Skinner	PALM-3609.US.P	8278
49637 7590 01/07/2008 BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069			EXAMINER COLIN, CARL G	
			ART UNIT 2136	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/844,924

Applicant(s)

SKINNER, CRAIG S.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/2007 has been entered.

### ***Response to Arguments***

2. In communications filed on 10/20/2007, applicant has cancelled claims 1-31 and adds claims 32-47, the following claims 32-47 are presented for examination.

2.1 Applicant's remarks, page 6, filed on 10/20/2007, with respect to the claims have been fully considered, but they are not persuasive. Applicant argues that the present claims are presented as being distinct from the references in view of the differences urged in the parent case. The following are stressed: running an application with a single encrypted record of only a serial number and an authorization level, an electronic device that is backdoor enabled, a single encrypted record of the individual serial number and the authorization level to control and claiming of the device. Examiner respectfully disagrees as the new claims recite some of the limitations already found in the previous claims. The final rejection (see pages 2-4) already

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addressed the items presented above by Applicant and is incorporated by reference. Upon further consideration, the rejection of claims 32-47 is set forth below.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 32-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 32 claims an enabling system for a backdoor enabled electronic device comprising: a single encrypted record...; a decryption structure...; a serial number comparator...; and an authorization level comparator... It appears that the elements of the claimed system are software related and they are not implemented in hardware. Therefore, the claims are directed to a system of software per se and are non-statutory subject matter. As shown in Applicant's specification, on pages 6-7, the encrypted record is defined as a data structure (page 6) and the decryption structure and comparators appear to be elements of the testing or backdoor application which are software. The signal cited in these claims is not embodied in a computer hardware.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.1 Claims 32-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's disclosure fails to recite testing decrypted serial number and testing representations of a decrypted access as claimed in claims 32, 36, and 44.

Claims 32, 36, and 44 recite testing the decrypted access level with the assigned authorization level of the device. Applicant's disclosure fails to recite such limitations since the decrypted access level and the assigned authorization level of the device are the same, in other words the assigned one is the one that has been encrypted (see applicant's specification page 6). Claims 35, 39, and 46 further recite allows access to said controlled attributes when said decrypted access level for said electronic device is of an equal or higher authorization level than said assigned authorization level. Applicant's disclosure fails to support such limitation (see page 7).

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 32, 33, 35-37, 39, 40, 44, and 46-47** are rejected under 35 U.S.C. 102(b) as being unpatentable over US Patent 5,933,497 to **Beetcher et al.**

As per claim 32, **Beetcher et al.** discloses an enabling system for a backdoor enabled electronic device having a stored serial number and an assigned authorization level for access to controlled attributes, comprising: an encrypted entitlement key containing a serial number and entitlement bits (see column 4, lines 4-8) that meets the recitation of *a single encrypted record of a serial number for said electronic device and a designated authorization level for the access of said electronic device to controlled attributes*; **Beetcher et al.** discloses that each customer receives a unique entitlement key enabling the customer to run only those software modules to which he is entitled (see column 4, lines 40-45); **Beetcher** also discloses other entitlements such as charge group, key type, serial number of the machine, and product entitlement field assigned to the device (see column 6, lines 20-40). In another embodiment, **Beetcher et al** discloses in column 7, lines 1-16, other authorization levels that are hardware specific assigned to said electronic device. There is suggestion in column 2, lines 49-53 that other entitlement may also be machine specific entitlement or authorization level assigned to a machine to make sure that a software is authorized to run on a specific machine that meets the recitation of *a designated authorization level for the access of said electronic device to controlled attributes*. **Beetcher et al.** discloses *a decryption structure for decrypting said single encrypted record to provide*

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*representations of a decrypted serial number for said electronic device and representations of a decrypted access level for said electronic device (see column 4, lines 9-12); Beetcher et al.* discloses verifying a decrypted unique machine identifier (serial number) against the stored one for controlling use of the device (see column 13, lines 1-8) that meets the recitation of *a serial number comparator for testing said decrypted serial number for said electronic device with said stored serial number to control enablement of said electronic device*; and further discloses verifying the decrypted entitlement bit for said electronic device to control access to unauthorized use, for example (see column 9, line 40 through column 10, line 20) that meets the recitation of *an authorization level comparator for testing said representations of a decrypted access level for an enabled electronic device with said assigned authorization level for said electronic device to control access to said controlled attributes*.

As per claim 36, **Beetcher et al.** discloses secured electronic system comprising: a backdoor enabled electronic device having a stored serial number and an assigned authorization level for access to controlled attributes (see column 4, lines 4-8 and column 6, lines 20-40); an encrypted entitlement key containing a serial number and entitlement bits (see column 4, lines 4-8) that meets the recitation of *a single encrypted record of a serial number for said electronic device and a designated authorization level for the access of said electronic device to controlled attributes*; **Beetcher et al.** discloses that each customer receives a unique entitlement key enabling the customer to run only those software modules to which he is entitled (column 4, lines 40-45); **Beetcher** also discloses other entitlements such as charge group, key type, serial number of the machine, and product entitlement field assigned to the

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device (see column 6, lines 20-40). In another embodiment, **Beetcher et al** discloses in column 7, lines 1-16, other authorization levels that are hardware specific assigned to said electronic device. There is suggestion in column 2, lines 49-53 that other entitlement may also be machine specific entitlement or authorization level assigned to a machine to make sure that a software is authorized to run on a specific machine that meets the recitation of a *designated authorization level for the access of said electronic device to controlled attributes*. **Beetcher et al.** discloses a *decryption structure for decrypting said single encrypted record to provide representations of a decrypted serial number for said electronic device and representations of a decrypted access level for said electronic device* (see column 4, lines 9-12); **Beetcher et al.** discloses verifying a decrypted unique machine identifier (serial number) against the stored one for controlling use of the device (see column 13, lines 1-8) that meets the recitation of a *serial number comparator for testing said decrypted serial number for said electronic device with said stored serial number to control enablement of said electronic device*; and further discloses verifying the decrypted entitlement bit for said electronic device to control access to unauthorized use, for example (see column 9, line 40 through column 10, line 20) that meets the recitation of an *authorization level comparator for testing said representations of a decrypted access level for an enabled electronic device with said assigned authorization level for said electronic device to control access to said controlled attributes*.

As per claim 44, **Beetcher et al.** discloses a process for enabling backdoor enabled electronic device having a stored serial number and an assigned authorization level for access to controlled attributes, comprising the steps of: storing on the electronic device, an encrypted



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entitlement key containing a serial number and entitlement bits (see column 4, lines 4-8) that meets the recitation of *storing on the electronic device a single encrypted record of a serial number for said electronic device and a designated authorization level for the access of said electronic device to controlled attributes*; **Beetcher et al.** discloses that each customer receives a unique entitlement key enabling the customer to run only those software modules to which he is entitled (column 4, lines 40-45); **Beetcher** also discloses other entitlements such as charge group, key type, serial number of the machine, and product entitlement field assigned to the device (see column 6, lines 20-40). In another embodiment, **Beetcher et al** discloses in column 7, lines 1-16, other authorization levels that are hardware specific assigned to said electronic device. There is suggestion in column 2, lines 49-53 that other entitlement may also be machine specific entitlement or authorization level assigned to a machine to make sure that a software is authorized to run on a specific machine that meets the recitation of a *designated authorization level for the access of said electronic device to controlled attributes*. **Beetcher et al.** discloses *decrypting said single encrypted record to provide representations of a decrypted serial number for said electronic device and representations of a decrypted access level for said electronic device* (see column 4, lines 9-12); **Beetcher et al.** discloses verifying a decrypted unique machine identifier (serial number) against the stored one for controlling use of the device (see column 13, lines 1-8) that meets the recitation of *comparing said decrypted serial number for said electronic device with said stored serial number to control enablement of said electronic device*; and further discloses verifying the decrypted entitlement bit for said electronic device to control access to unauthorized use, for example (see column 9, line 40 through column 10, line 20) that meets the recitation of *testing said representations of a decrypted access level for an*

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*enabled electronic device with said assigned authorization level for access to control accesses for said electronic device to access to said controlled attributes.*

As per claims 33 and 37, **Beetcher et al.** discloses wherein said single encrypted record is stored on said electronic device (see column 4, lines 4-8).

As per claims 35, 39, and 46, **Beetcher et al.** discloses wherein said authorization level comparator allows access to said controlled attributes when said decrypted access level for said electronic device is of an equal or higher authorization level than said assigned authorization level, for example (see column 10, lines 56-60).

As per claims 40 and 47, **Beetcher et al.** discloses wherein said electronic device receives said stored serial number at the time of manufacture (see column 7, lines 15-16).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

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which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 41-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,933,497 to **Beetcher et al.**

As per claims 41-43, **Beetcher et al.** does not explicitly disclose a computer system comprising a wireless device such as PDA that includes Internet capability. However, **Beetcher et al.** suggests that the invention is not limited to a particular computer system (see column 5, lines 33-35. Examiner takes official notice that such computer system is well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention disclosed by **Beetcher et al** into a portable device such as a PDA because it could be used anywhere and would allow a user to access the Internet and other applications from anywhere and not restricted to one physical location.

7. **Claims 34, 38, and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,933,497 to **Beetcher et al.** in view of US Patent 6,526,512 to **Siefert et al.**.

As per claims 34, 38, and 45, **Beetcher et al.** discloses locking in memory the version number the product number, serial number etc. and also discloses codes stored in read-only memory (ROM) to make it not capable of alteration by customers, for example (see column 7, lines 15-30 and column 9, lines 49-67). **Beetcher et al** is silent about storing as a locked flash

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record. It is well known in the art of computer security that computers have flash memory and using a flash memory will not depart from the spirit and scope of the invention of **Beetcher et al.** **Siefert et al.** also discloses using read-only memory (ROM) for the encrypted data and serial number. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store said encrypted record and serial number in locked flash record in said electronic device as suggested by **Beetcher et al.** One skilled in the art would have been lead to make such a modification to prevent alteration of these data by customers.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the prior art discloses device access based on authorization level and authentication. See PTO-form 892.

8.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Colin/

Carl Colin

Patent Examiner, A.U. 2136

December 27, 2007